

57-26-04  
Attorney's Docket No. 038190/268379

EXAMINER'S DRAFTING & REF.  
DIVISION #307

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re: Burford *et al.*

Appl. No.: 10/706,480

Applicant Filed: October 27, 2003

USPTO Date Entered: April 7, 2004

For:

SYSTEM AND ASSOCIATED FRICTION STIR WELDING (FSW)  
ASSEMBLY, CONTROLLER AND METHOD FOR PERFORMING  
A FRICTION STIR WELDING OPERATION

Confirmation No.: 8066 2004 JUL 30 PM 3:10  
Group Art Unit: 1725



Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Request for Reconsideration of  
Petition To Grant Filing Date And To Refund Petition Fee**

This is a Request for Reconsideration of our Petition filed April 7, 2004, wherein Applicants petitioned to grant the proper filing date of October 27, 2003, for the above-identified patent application.

Applicants' Petition was dismissed June 10, 2004. The Petitions Examiner has stated that Applicants have not submitted a proper return postcard showing that the application was filed October 27, 2003. However, the Patent Office did not properly stamp Applicants' postcard. Instead, the Patent Office returned Applicants' postcard with the stamp by the Office of License and Review and the date that the Office of License and Review received it. Therefore, it is the Patent Office who improperly stamped Applicants' postcard, thereby leaving Applicants without a properly stamped postcard to produce as evidence.

On October 27, 2003, Applicants sent a United States Postal Service Package to Mail Stop Patent Application (see Exhibit A). The package contained two filings for the same invention: 1) a complete application as outlined on Applicants' return postcard (see Exhibit B); and 2) a Request for Foreign Filing License accompanied by a copy of the specification and drawings as well as another return postcard specifically drawn to the Request for Foreign Filing License (see Exhibit C).

Both of Applicants' postcards are stamped "Received Oct. 30, 2003 Licensing & Review." Applicants can only surmise that when the package was received by Patent Office

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In re: Burford *et al.*  
Appl. No.: 10/706,480  
Applicant Filed: October 27, 2003  
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DIVISION

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personnel at Mail Stop Patent Application, the package was not separated out into two different filings, each being separately clipped together by Applicants along with its own postcard. The patent application was not retained for proper processing and stamping of the postcard with an application number and the correct date of October 27, 2003. But instead, the complete application with 25 pages of specification and six pages of drawings and other accompanying documents, as well as the Petition for Foreign Filing License with its copy of the specification and drawings, were forwarded to Licensing and Review, which stamped both postcards October 30, 2003. Only the Petition for a Foreign Filing License and the copy of the specification attached to it with its postcard clipped on top should have been forwarded to Licensing and Review.

As further evidence that the Patent Office did indeed receive a complete copy of the specification and drawings, Applicants also submit herewith as Exhibit D a copy of the foreign filing license granted by the Office of License and Review on October 31, 2003. According to 37 C.F.R. §§ 5.13 and 5.14, when a petition for a foreign filing license is made in the Patent Office, the petition must be accompanied by the material or the disclosure of a patent application upon which the desired license is measured. Since the Office of License and Review granted a foreign filing license for the present application on October 31, 2003, the Patent Office must have had the specification and drawings as the measure upon which the license was granted at least as far back as October 30, 2003, the date stamped on the return postcard and indicated as being the request date on the foreign filing license. Moreover, since the specification and drawings must have accompanied the petition, and the petition for a foreign filing license was included in the aforementioned United States Postal Service Package sent on October 27, 2003, the specification and drawings of the present application must have also been included in the aforementioned package.

Applicants therefore respectfully request that the filing date of October 27, 2003 (the date on the Express Mail Label which date also appears on Applicants' return postcard) be granted. Applicants further believe that if the Examiner cannot grant this date, that there is a preponderance of evidence that the Patent Office had the complete application on October 30, 2003. The Applicants should not be burdened because Patent Office personnel improperly

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Applicant Filed: October 27, 2003  
USPTO Date Entered: April 7, 2004  
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handled the application by forwarding both separately clipped sets of documents to Licensing and Review, and did not hold and process the application that was separately clipped with its own postcard. Moreover, Applicants' petition should not be denied because of the improper processing of the present application and the improper stamping of Applicants' return postcard has left Applicants without the postcard the Petitions Examiner is requesting.

It is Applicants' understanding that there is no charge for a Request for Reconsideration of our Petition. And because no defect existed in Applicants' originally filed patent application, Applicants request a filing date of October 27, 2003, and respectfully also request a refund of the previously paid \$130.00 petition fee.

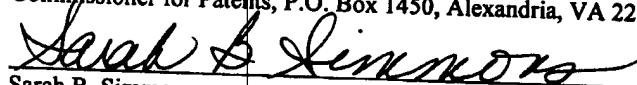
Respectfully submitted,

  
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"Express Mail" mailing label number EV 331631265 US  
Date of Deposit July 23, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

  
Sarah B. Simmons  
CLT01/4658231v1

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**Exhibit A**  
**Copy of Applicant's U.S. Postal Service Express Mail label.**

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Customer Copy  
Label Thru June 2002

 EV 331608718 US		<b>EXP. MAIL</b> UNITED STATES POSTAL SERVICE			
<b>Post Office To Addressee</b>					
DELIVERY (POSTAL USE ONLY)					
<b>ORIGIN (POSTAL USE ONLY)</b> <b>PO ZIP Code:</b> 28215 <b>Day of Delivery:</b> <input checked="" type="checkbox"/> Next Day <input type="checkbox"/> Second <b>Date In:</b> 10/27/04 <b>Postage:</b> <input type="checkbox"/> <b>Mo. Day:</b> 10/27/04 <b>12 Noon:</b> <input type="checkbox"/> <b>3 PM:</b> <input type="checkbox"/> <b>Timeline:</b> <b>68</b> <b>Military:</b> <input type="checkbox"/> <b>AM:</b> <input type="checkbox"/> <b>PM:</b> <input type="checkbox"/> <b>2nd Day:</b> <input type="checkbox"/> <b>3rd Day:</b> <input type="checkbox"/> <b>Weight:</b> <b>5</b> lbs <b>Int'l Alpha Country Code:</b> <input type="checkbox"/> <b>COD Fee:</b> <input type="checkbox"/> <b>Insurance Fee:</b> <input type="checkbox"/> <b>Itms.:</b> <b>025.</b> <b>No Delivery:</b> <input type="checkbox"/> <b>Weekend:</b> <input type="checkbox"/> <b>Holiday:</b> <input type="checkbox"/> <b>CUSTOMER USE ONLY</b> <b>METHOD OF PAYMENT:</b> <input type="checkbox"/> Express Mail Corporate Acct. No. <b>X282641</b>		<b>Delivery Attempt:</b> <input type="checkbox"/> AM <input type="checkbox"/> PM <b>Employee Signature:</b> _____ <b>Delivery Attempt:</b> <input type="checkbox"/> AM <input type="checkbox"/> PM <b>Employee Signature:</b> _____ <b>Delivery Date:</b> <input type="checkbox"/> AM <input type="checkbox"/> PM <b>Employee Signature:</b> _____ <b>Mo. Day:</b> <input type="checkbox"/> AM <input type="checkbox"/> PM <b>Employee Signature:</b> _____			
Federal Agency Acct. No. _____ Postal Service Acct. No. _____					
<b>FROM: (PLEASE PRINT)</b> <b>704 444 1000</b> <b>HALSTON &amp; BIRD LLP</b> <b>BANK OF AMERICA PLAZA</b> <b>101 S TRYON ST STE 4000</b> <b>CHARLOTTE NC 28280-4000</b>  <b>HTS: 03810-268379</b>				<b>TO: (PLEASE PRINT)</b> <b>MAIL STOP PATENT APPLICATION</b> <b>COMMISSIONER FOR PATENTS</b> <b>PO BOX 1450</b> <b>ALEXANDRIA VA 22313-1450</b>	

CHARLOTTE AIRMAIL CENTER CHARLOTTE North Carolina 282199798	(704)359-8638	06:35:28 PM	06:35:28 PM	06:35:28 PM
0/27/2003	Sales Receipt	Unit Price	Final Price	\$13.65
Express Mail	EL822754698US			
DATE	Serial Number			
2nd Day 3PM	Delivery			
Paid by account:	EMCA account number:	\$13.65		282641
EX-ANDRIA VA 22313	Express Mail			\$17.85
Serial Number	Next Day Noon			EV331608718US
Delivery	Paid by account:			
EMCA account number:	EMCA account number:	\$17.85		282641
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PATENT MAINTENANCE  
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**Exhibit B**  
**Applicant's Patent Application Postcard**

This postcard was clipped on top of the complete application filing. All of the documents listed on the postcard were enclosed.

*Mail Stop Patent Application*  
Commissioner for Patents  
P.O. Box 1450

Date Mailed: 10-27-03

Alexandria, VA 22313-1450

Atty. Dkt. No. 038190/268379

Kindly acknowledge receipt of the accompanying utility PATENT APPLICATION with Application Transmittal Cover Sheets for:

Inventor(s): Dwight R. Burford, Edwin H. Fenn, Danny R. High, Robert M. May  
Title of Invention: SYSTEM AND ASSOCIATED FRICTION STIR (FSW) ASSEMBLY  
CONTROLLER AND METHOD FOR PERFORMING A FRICTION STIR WELDING OPERATION  
Pages of Spec. (including claims and abstract) 25; No. of Claims 20  
No. of Drawing Sheets 6; Declaration Enclosed YES (3 pages); EDS with PTO  
1449 Enclosed YES; (No. of 1449 Cites Enclosed 1); Assignment with Cover  
Sheet and \$40.00 Fee Enclosed YES

Other Documents: Request for Early Publication; Petition for License for Foreign Filing  
Check(s) Enclosed \$856.00; \$300.00; \$130.00; \$40.00

Please place office stamp hereon and Return Postcard to : Sarah B. Simmons/ATS  
ALSTON & BIRD LLP

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**Exhibit C**  
**Applicant's Petition for Foreign Filing License Postcard**

This postcard was clipped on top of the Petition for Foreign Filing License with a copy of the Specification and Drawings attached.

*ATTENTION: Licensing and Review*  
Mail Stop Patent Application

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Application No. (To be assigned) ; Filing Date (Concurrently herewith)  
Inventor(s): Dwight A. Burford, Edwin H. Fenn, Danny R. High, Robert M. Kay; Title of Invention: SYSTEM AND ASSOCIATED FRICTION STIR

WELDING (FSW) ASSEMBLY, CONTROLLER AND METHOD FOR  
PERFORMING A FRICTION STIR WELDING OPERATION

Documents Enclosed: Petition for License for Foreign Filing  
Check Enclosed \$130.00

Kindly acknowledge receipt by placing office stamp hereon and  
returning postcard to: Sarah B. Simmons/ATS  
ALSTON & BIRD LLP

Date Mailed: 10-27-03  
Atty. Dkt. No. 038190/268379

2003

AVAILBLE COPY

**Exhibit D**  
**Copy of Applicants' Foreign Filing License Granted Oct. 31, 2003**

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ATB



**UNITED STATES PATENT AND TRADEMARK OFFICE**

COMMISSIONER FOR PATENTS  
 UNITED STATES PATENT AND TRADEMARK OFFICE  
 WASHINGTON, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
P-108,155	10/30/03	DWIGHT A. BURFORD, ET AL.	038190/268379

TITLE:

**SYSTEM AND ASSOCIATED FRICTION STIR WELDING (FSW)  
 ASSEMBLY, CONTROLLER AND METHOD FOR PERFORMING A  
 FRICTION STIR WELDING OPERATION**

Correspondence Address:

ANDREW T. SPENCE  
 ALSTON & BIRD LLP  
 BANK OF AMERICA  
 101 SOUTH TRYON STREET, SUITE 400  
 CHARLOTTE, NC. 28280

Art Unit	Paper Number
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Alston & Bird

NOV 7 2003

Received By *[Signature]*

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 531,532  
 Grant Date: 31-Oct-03

Approved:

for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license is granted under 37 CFR 5.15(a)

This license is to be retained by the licensee and may be used at anytime on or after the date thereof.  
 This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

**LICENSE FOR FOREIGN FILING**  
 [Title 35, United States Code (1952) Sections 184, 185, 186]